REMARKS

Applicants believe that the following comments will convince the Examiner that the rejections set forth in the September 4, 2003 Office Action have been overcome and should be withdrawn.

Furthermore, Applicants are submitting herewith a terminal disclaimer to limit the term of the patent resulting from this application to that of Applicants' U.S. Pat. No. 6,164,534 (the "'534 patent"). Applicants want to bring the '534 patent to the Examiner's attention since the Examiner may believe its claims are not patentably distinct from (or in fact encompass) the present invention. Claim 1 from the '534 patent is illustrative:

> 1. A system for displaying programming to a user, the system comprising:
>
> a printed matter having at least one machine recognizable feature;
>
> a feature recognition unit having associated therewith a means for recognizing said feature and a transmitter for transmitting a coded signal in response to the recognition of said feature;
>
> an intelligent controller having associated therewith a receiver for receiving said coded signal and means for accessing programming material; and
>
> a display unit for presenting said programming material;
>
> wherein said recognition unit, in response to the recognition of said feature, causes said

intelligent controller to access said programming material and said display unit to execute or display said programming material.

I. THE INVENTION

Generally, the present invention is a system for accessing electronic data via a familiar printed medium. Specifically, the familiar printed medium is a printed official document comprising at least one machine recognizable feature, which may be one of various embodiments including, but not limited to, a watermark, bar code, invisible bar code, magnetic code, printed character, invisible icon, etc. In the present invention, a machine recognizable feature is scanned or sensed, and converted into an electronic signal, which is transmitted for processing. In response to the electronic signal, programming material related to the information contained in the official document is displayed. Importantly, the present invention is designed to allow a user to access programming material related to the official document.

II. THE EXAMINER'S REJECTIONS

The Examiner rejected claims 168-201, 204-206, 223, 224, 240, 249-256, 261-264, 267-270, 275-277, 280, 291, 296, and 298-301 under 35 U.S.C. § 103(a) as being

unpatentable over Withnall *et al.* U.S. Patent No. 4,488,035 (hereinafter referred to as "Withnall") in view of Fields U.S. Patent No. 4,481,412 (hereinafter referred to as "Fields") and Li *et al.* U.S. Patent No. 5,506,697 (hereinafter referred to as "Li"). The Examiner opined that Withnall discloses a system that includes a feature recognition device that reads at least one machine recognizable feature on a travel ticket to display information on the display of a portable handset. However, the Examiner admitted that:

> "Withnall fails to teach or fairly suggest that the displayed information is programming material and the system further comprising means for transmitting a coded signal in response to the recognition of the machine recognizable feature and an intelligent controller having associated therewith a means for accessing the programming material in response to receiving the coded signal." (September 4, 2003 Office Action, pp. 3-4).

The Examiner contended that Fields teaches these features by disclosing a microcontroller accessing means that includes a "barcode electronic circuit" coupled to a barcode reader, wherein the microcontroller accesses and transmits programming material in response to receiving a coded signal. The Examiner argued that the system disclosed in Fields displays "video/image/programming/

sound/pictorial/electronic/media data" on a "television/ workbook."

The Examiner stated that combining the systems disclosed in Withnall and Fields would have been obvious at the time of Applicants' invention to provide:

> "Withnall with a higher technology system wherein the user being provided with a variety of information in flexible ways. . . .such modification would have been an obvious extension as taught by Withnall et al." (September 4, 2003 Office Action, p. 4).

The Examiner then admitted that the Withnall and Fields combination fails to teach or suggest a printed official document, which is argued to be taught by Li. The Examiner stated that combining Li with Withnall and Fields would have been obvious for providing:

> "a more secure system wherein official documents can be prevented from being accessed by an unauthorized person due to the benefit of a machine recognizable symbol/barcode, and thus providing a more user-friendly system wherein the user does not have to be concerned about whether the user's lost/stolen official document is read by a fraudulent user. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields." (September 4, 2003 Office Action, pp. 4-5).

The Examiner then admitted that Withnall, Fields, and Li fail to disclose a printed official document that is a license, registration, passport, visa, Green Card, license plate, tag, decal, parking permit, Social Security Card,

health insurance card, Medicaid card, deed, invoice, receipt, bill of sale, library card, newsletter, application form, lottery ticket, etc. The Examiner asserted that modifying the Withnall, Fields, and Li combination to use such official documents would have been:

> "a substitution of a functional equivalent which does not change the underlying inventiveness of Withnall/Fields/Li's teachings. Furthermore such modification would have been an obvious design variation." (September 4, 2003 Office Action, p. 5).

Also, the Examiner rejected claims 202, 203, 208-210, 212, 217, 218, 220, 221, and 242-247 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Li "as applied to claim 168" in view of Roberts U.S. Patent No. 5,324,922 (hereinafter referred to as "Roberts") and Malec *et al.* U.S. Patent No. 5,287,266 (hereinafter referred to as "Malec"). The Examiner admitted that Withnall, Fields, and Li fail to teach online or home shopping and a cable television data link, and argued that these features are disclosed by Roberts. According to the Examiner, the combination of Roberts with Withnall, Fields, and Li would have been obvious and would provide:

> "a faster internet system due to the benefit of cable television transmitting capability. Furthermore, such modification would have been an obvious extension as taught by Withnall

> /Fields/Li to provide the user with an alternative way of conducting shopping at his/her convenience." (September 4, 2003 Office Action, p. 6).

Moreover, the Examiner admitted that Withnall, Fields, Li, and Roberts all fail to disclose an Integrated Services Digital Network ("ISDN") data link which, according to the Examiner, is disclosed by Malec. In the opinion of the Examiner, the combination of Malec with Withnall, Fields, Li, and Roberts would have been obvious for providing:

> "a more accurate and faster system due to the benefit of ISDN networking line[s]. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Li/Roberts and would have merely been a substitution of equivalents." (September 4, 2003 Office Action, p. 6)

Next, the Examiner rejected claims 207, 210, 214-216, 219, 222, 227-229, 231, 232, 237, 238, 241, 249-260, 265, 266, 274, 279, 281-283, 294, and 297 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Li "as applied to claims 168 and 296" in view of Bravman *et al.* U.S. Patent No. 5,401,944 (hereinafter referred to as "Bravman"). The Examiner admitted that Withnall, Fields, and Li fail to teach displaying information on a wireless communication device. According to the Examiner, Bravman teaches a remote unit providing travel-related information, and the combination of

Withnall, Fields, Li, and Bravman would have been obvious for providing:

> "a more flexibile system wherein the system is capable of providing the user all of his/her desired information about the trip/vacation that he/she is about to take, and thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Li." (September 4, 2003 Office Action, p. 7).

Also, the Examiner rejected claims 225, 230, and 233 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Li "as applied to claim 168" in view of Waterbury German Patent No. DE 24 52 202 A1 (hereinafter referred to as "Waterbury"). The Examiner admitted that Withnall, Fields, and Li fail to teach an invisible machine recognizable feature, which the Examiner argued is taught by Waterbury. The Examiner asserted that the combination of Waterbury with Withnall, Fields, Li would have been obvious for providing:

> "an improved security system wherein the data recorded in the machine recognizable feature is invisible to the naked eye, and thus preventing an unauthorized individual from manipulating the data. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Li." (September 4, 2003 Office Action, p. 8).

Additionally, the Examiner rejected claims 226 and 240 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Li "as applied to claim

168" in view of Tannehill *et al.* U.S. Patent No. 5,158,310 (hereinafter referred to as "Tannehill"). The Examiner admitted that Withnall, Fields, and Li fail to teach a magnetic code strip, which the Examiner argued is taught by Tannehill. According to the Examiner, the aforementioned combination would have been obvious for providing Withnall, Fields, and Li with an alternative method for encoding data: "such modification would have been merely a substitution of equivalents." (September 4, 2003 Office Action, p. 9).

Also, the Examiner rejected claims 234-236 and 239 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Li "as applied to claim 168" in view of Schach *et al.* U.S. Patent No. 5,397,156 (hereinafter referred to as "Schach") and Waterbury. The Examiner admitted that Withnall, Fields, and Li fail to teach a watermark, which the Examiner argued is taught by Schach. In the Examiner's opinion, the combination of Schach with Withnall, Fields, and Li would have been obvious for aesthetic purposes. "[S]uch modification would have been an obvious extension as taught by Withnall/Fields/Li." (September 4, 2003 Office Action, p. 9).

The Examiner then admitted that Withnall, Fields, Li, and Schach fail to teach an invisible watermark, which the Examiner argued is taught by Waterbury. The Examiner asserted that the combination of Withnall, Fields, Li, Schach, and Waterbury would have been obvious for providing:

> "a more secure system wherein the data recorded in the machine recognizable feature is invisible to the naked eye, thus preventing manipulating [sic] by a fraudulent user. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Li/Schach." (September 4, 2003 Office Action, p. 10).

Last, the Examiner rejected claims 213, 271-273, 278, 279, 284-290, 292, 293, and 295 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Li "as applied to claim 168" in view of Morales U.S. Patent No. 5,872,589 (hereinafter referred to as "Morales"). The Examiner admitted that Withnall, Fields, and Li fail to teach a display unit comprising a "personal planner/phone/pager," which is argued to be taught by Morales. In the Examiner's opinion, combining Withnall, Fields, Li, and Morales would have been obvious to provide:

> "the user with the flexibility of selecting his/her desired display unit that is more suitable for his/her needs, thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Li." (September 4, 2003 Office Action, p. 10).

III. **THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN**

The Examiner rejected claims 168-201, 204-206, 223-224, 240, 249-256, 261-264, 267-270, 275-277, 280, 291, 296, and 298-301 under 35 U.S.C. § 103(a) as being unpatentable over Withnall in view of Fields and Li. Applicants respectfully disagree and submit that none of the aforementioned claims are obvious in view of Withnall, Fields, and Li. In order for a claimed invention to be obvious in view of a combination of references, three criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the claim limitations. (*see In re Vaeck,* 947 F.2d 488; MANUAL OF PATENT EXAMINING PROCEDURE §§ 2143-2143.03).

Initially, Applicants submit that no suggestion or motivation to modify or combine Withnall, Fields, and Li exists.

> "Standing on their own, these references provide no justification for the combination asserted by the Examiner. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of

> references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original).

The Examiner contended that it would have been obvious to combine the teachings of Withnall, Fields, and Li to arrive at the various embodiments of Applicants' invention. Yet, the Examiner has cited only purported benefits of this combination without pointing to what motivation is provided by the references themselves. Applicants submit that no combination of these references would have been obvious to one of skill in the art at the time of Applicants' invention. Specifically, Withnall discloses a system for utilizing barcodes on commuter tickets to test for validity. The Examiner suggests that "travel information which can be retrieved once barcode [sic] on the ticket has been read can be considered programming material...associated with the barcode." (September 4, 2003 Office Action, p. 11) Applicants respectfully submit however, that this does not constitute programming material. The "travel information" referred to by the Examiner is encoded within the barcode on the ticket. The system of Withnall *reads* this information from the barcode, it does not *retrieve* it from a separate database. The barcode or the data encoded therein do not themselves

constitute programming material. Indeed, the only interaction the barcode has with a database is a mere validity check, i.e., the comparison of data *on* the ticket to stored reference data.

This purpose is far removed from the intent of the training system disclosed by Fields. The training system of Fields is used to provide a user with audio/visual output from a videodisc player coinciding with material presented in a training manual. Fields relies on a read-only videodisc thereby sacrificing updatability and flexibility. In fact, Fields does not even contemplate the ability to interface with a remote server or an updatable video source. Thus, there is no suggestion to combine a travel ticket verification system that does not provide programming material with a training system that automatically cues to a certain frame on a videodisc. The mere fact that Fields and Withnall can use a barcode is an insufficient basis to suggest their combination.

Neither Withnall nor Fields relate to Li, which teaches the use of two-dimensional bar codes to encode documents. The bar code can be transmitted to a remote location and scanned to recreate the document. The document that is recreated does not consist of programming material, however, because the document itself is encoded

in the barcode. It is not used to direct retrieval of programming material from a database. Li merely translates the barcode into a document. Furthermore, Li teaches against the combination asserted by the Examiner. Li encourages that only data relating to the composition of the document itself should be encoded:

> "The present invention is directed to the processing of documents containing humanly readable printed information and a machine readable symbol encoded to represent the printed information. The symbol is then scanned to enter the printed information contained in the document. The symbol is optically read to generate symbol data which is converted to document data by a computer. A printer, connected to the computer, prints out the document data to create a second document containing at least a portion of the printed information contained in the original document." (col. 1, line 65 through col. 2, line 7)

> "It should be noted that throughout this application, whenever a single symbol is shown, in the event the capacity requirements for storing the printed information 22a exceeds that of a single symbol, multiple symbols may be used." (col. 3, line 67 through col. 4, line 4)

> "[H]umanly readable data on a document is encoded in a machine readable format which can be easily read by a machine, such as a computer, for editing and transmission to a remote site. By providing a document that is both machine-readable and human-readable, the document can be readily recreated and disseminated. . . . In FIG. 1, an original document 20 bears an encoded symbol 22 and typically, but not necessarily, printed information 22a. Symbol 22 is encoded with information relating to the entire printed information 22a on the document 20, or relating to at least a portion of the printed information

> 22a on the document 20. The encoded information in the symbol 22 may include information, such as, for example type font of the printed information 22a, format information, such as margin and tab settings, for the printed information 22a, as well as at least a portion of the printed information 22a itself." (col. 3, lines 40-57).

Because Li only suggests that the encoded information be merely a storage means for the printed information on the document itself, he implicitly teaches against programming material. Li is directed to a system that allows electronic document recreation, reproduction, and distribution, i.e., a "virtual paper or dynamic document environment". (Li, col. 3, lines 38-39). This functionality is merely duplication. Using the barcode of Li to direct a user to programming material would be completely at odds with Li since the user would not be provided with the document itself. Thus, Li teaches against the combination asserted by the Examiner by requiring that the barcode be merely an encoded representation of at least part of the document on which it is printed.

The differing purposes of these references have no overlap in use, and therefore, would not provide one skilled in the art with a motivation or suggestion to combine these references. Thus, an inventive step must be

performed for one skilled in the art to arrive at the idea of combining any features of Withnall, Fields, and Li in any combination.

Upon reconsideration, the Examiner will undoubtedly recognize that the reasons put forth for the § 103(a) rejection actually support an "obvious to try" argument. Of course, "obvious to try is not the standard for obviousness under 35 U.S.C. § 103." Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 91 (Fed. Cir. 1986).

Under these circumstances, Applicants respectfully submit that the Examiner has succumbed to the "strong temptation to rely on hindsight." Orthopedic Equipment Co. v. United States, 702 F. 2d 1005, 1012, 217, U.S.P.Q. 193, 199 (Fed. Cir. 1983):

> "It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law."

Applicants submit that the only suggestion or motivation for the Examiner's combination of references is provided by the teachings of Applicants' disclosure. No such suggestion or motivation is provided by the references

themselves; nor could there be in view of the difference in subject matter and the corresponding goals thereof.

In addition to the lack of suggestion or motivation to combine Withnall, Fields, and Li, there is no expectation of success for the combination of these references, and any possible resulting device would not teach or suggest all of the limitations of the rejected claims. Withnall discloses a machine capable of scanning a bar code on a commuter ticket and subsequently displaying the validity of the ticket based on information stored in a memory means. Fields discloses a system for reading a bar code on a training manual for playing corresponding material from a videodisc. Li discloses a system for reading document information from within a two-dimensional bar code for transmission via facsimile. Applicants respectfully submit that the combination of Withnall, Fields, and Li cannot be successfully combined to disclose the means for accessing programming material associated with a database or the printed official document having a machine recognizable feature of the claimed invention. Importantly, claims 168, 296, and 299 all disclose the accessing of programming material resulting from recognition of a machine recognizable feature. The programming material of the present invention is designed such that it can be easily

altered or updated at any time. As a result, a user will be provided with the most recently updated version of the associated information (or programming material) upon scanning an official document. This is not possible with the combination of Withnall, Fields, and Li. Any attempt of implementing the videodisc player of Fields with Withnall would require the videodisc player to be located on a vehicle, e.g., a bus. Therefore, anytime information must be updated, a new videodisc must be inserted into the videodisc player. This is not feasible, especially because the validity of a ticket can change each time a ticket is used and could require a new videodisc to be employed every time a ticket is used. Moreover, the radio data link of Withnall cannot be utilized to access a remote videodisc player or other such audio/visual material because the radio data link is designed only for transmitting a validity state and not substantially different audio/visual material. In particular, audio/visual material requires substantially more data to be transmitted in a specialized format. Thus, a system for achieving such transmission would need to be invented and implemented for remotely accessing such material. Moreover, the addition of Li to Withnall and Fields would not be successful because Li is designed to transmit information contained in the document

upon which the barcode is printed—as opposed to programming material. Thus, the system must be reconfigured to transmit information from within a bar code to access programming material that must be somehow perceived by the user. No feature of Withnall or Fields provides the capability of transmitting programming material from a remote site back to a user. Furthermore, this would not be possible without performing an additional inventive step.

In sum, any attempt to combine Withnall, Fields, and Li to create the present invention would be unsuccessful and fails to provide the flexible, updateable system including a system for obtaining and surveying correlated programming material of the claimed invention as opposed to a comparison of the identity of a printed code with a code stored in a database. Moreover, the dynamic programming material of the claimed invention is not disclosed by the combination of these references.

In view of the foregoing, base claims 168, 296, and 299 cannot be unpatentable over Withnall, Fields, and Li. The remaining rejected claims are dependent on these claims and contain all of the limitations of their respective base claims. Therefore, these dependent claims are also not unpatentable over these references.

In all subsequent rejections, the Examiner noted the deficiencies of the Withnall, Fields, and Li combination regarding matter disclosed in dependent claims and appended various other references including Roberts, Malec, Bravman, Waterbury, Tannehill, Schach, and Morales to the combination in order to provide the additional features of the dependent claims. However, the combination of Withnall, Fields, and Li has been shown to be not only improper, but also to lack the disclosure of each and every element of the base claims. Because this combination is improper and incomplete, any further combination of references with Withnall, Fields, and Li would also be improper. Thus, Applicants respectfully submit that all remaining rejections have also been overcome and should be withdrawn.

CONCLUSION

Applicants submit that all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. Early and favorable action is accordingly solicited.

Respectfully submitted,

Date: 3/3/04

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